REMARKS

Claims 1 and 15 have been amended to require the presence of a specific amount of the compound of formula (I). Support for this amendment exists, *inter alia*, at page 7, line 3 of the present application. Because claims requiring the presence of specific amounts of this compound are already under consideration (see, for example, claim 4), no new issues have been raised by this amendment. Applicants respectfully request entry and consideration of the claims as amended.

Claim 8 has been amended in a grammatical, non-limiting manner.

Claims 1-18 are currently pending.

The Office Action rejected claims 1-3, 5 and 12-16 under 35 U.S.C. §102 as anticipated by FR 2,779,060 ("Boussouira" -- which corresponds to U.S. patent 6,358,514 ("US '514")), and claims 1-18 under 35 U.S.C. §103 as obvious over U.S. patent 5,705,144 ("Harding") in view of U.S. patent 5,302,376 ("Forestier"). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

Regarding the §102 rejection, Boussouira neither teaches nor suggests compositions containing 0.5-5 % of the compounds of formula (I) and a retinoid. Boussouira is silent concerning such subject matter. The Examiner has presumably recognized this deficiency in Boussouira's disclosure which explains why claim 4 (which is directed to the amount of formula (I) compound present) was not rejected over Boussouira.

In view of the above, Applicants respectfully submit that the rejection of claims 1-3, 5 and 12-15 based on Boussouira is improper and should be withdrawn.

What's more, Boussouira neither teaches nor suggests the claimed compositions for several other reasons. Boussouira discloses compositions in which retinoids are stabilized with histidine derivatives. Boussouira indicates that any sunscreen agent can be added to "reinforce the stability of the combination of the retinoid with the polyamino polymer, by limiting the harmful action of UV on the retinoid." (Col. 7, lines 55-57 of US '514). Boussouira's disclosure is fatally deficient in several ways.

First, Boussouira neither teaches nor suggests the claimed combination of retinol and the claimed camphorsulphonic acid derivatives. At most, Boussouira generally suggests combining any retinoid with any sunscreen agent. As a matter of law, such a general disclosure relating to the theoretical combination of potentially thousands of vitamin A derivatives with thousands of sunscreen agents cannot anticipate the specific subject matter of the claimed invention. *See, In re Meyer*, 599 F.2d 1026 (CCPA 1979); *Akzo v. International Trade Comm'n,* 808 F.2d 1471 (Fed. Cir. 1986). Boussouira provides no motivation or guidance to combine retinol with the claimed camphorsulphonic acid derivatives with the expectation that the claimed retinol stability would result.

Second, Boussouira neither teaches nor suggests compositions in which about 90% of the retinol remains after two months at 45°C (or less than about 10% of the retinol is decomposed after two months at 45°C). Boussouira neither teaches nor suggests such retinol stability, either expressly or inherently, and the Office Action presents no evidence indicating that Boussouira discloses such retinol-stable compositions.

Third, Boussouira does not disclose that sunscreens stabilize retinoids, but rather that sunscreens reinforce the stability of the retinoid/histidine combination. (Col. 7, lines 54-57 of US '514).

Fourth, Boussouira neither teaches nor suggests that certain UVA sunscreens decompose retinol, whereas other UVA sunscreens do not. Based solely on Boussouira, one skilled in the art would not know which UVA sunscreens, if any, to combine with retinol to minimize retinol decomposition. Boussouira's general statement that sunscreens reinforce the stability of his retinoid/histidine combination by limiting the harmful action of UV on the retinoid in no way teaches or suggests the present invention which addresses problems primarily associated with retinol instability caused by the sunscreen agent itself.

For these reasons as well, Applicants respectfully submit that the rejection of claims 1-3, 5 and 12-15 based on Boussouira is improper and should be withdrawn.

Regarding the rejection of claim 16 under § 102, Applicants respectfully request independent reconsideration and withdrawal of this rejection.

Claim 16, which is directed to methods of minimizing retinol degradation, is neither taught nor suggested by Boussouira. Boussouira does not disclose the specific combination of retinol and the claimed camphorsulphonic derivatives, meaning that Boussouira can not teach, suggest or recognize any retinol decomposition minimizing benefits resulting from such a combination.

Moreover, one skilled in the art, following Boussouira's disclosure, would not have been led to make the specific combination of retinol with the claimed camphorsulphonic derivatives with the expectation that retinol degradation would

be minimized. Boussouira suggests equivalence between Parsol 1789 and the claimed sunscreens. However, the test results on page 10 of the present application show that UVA sunscreen Parsol 1789 degrades retinol, whereas the claimed camphorsulphonic derivatives do not. Thus, Parsol 1789 and the claimed sunscreens are not equivalent with respect to retinol degradation properties. Nothing in Boussouira would have led one skilled in the art to appreciate/understand the claimed camphorsulphonic derivatives' unique properties with respect to minimizing retinol degradation. Thus, nothing in Boussouira would have led one skilled in the art to the claimed methods.

In view of the above, Applicants respectfully submit that the rejection of claim16 under 35 U.S.C. § 102 is improper and should be withdrawn.

Regarding the §103 rejection, Applicants respectfully submit that no *prima facie* case of obviousness has been established. It is undisputed that Harding fails to disclose or suggest combining retinol with the claimed UVA sunscreen agents or any benefits resulting from such a combination. Indeed, Harding does not disclose the claimed camphorsulphonic sunscreens.

Moreover, Harding neither teaches nor suggests that certain UVA sunscreens decompose retinol, whereas other UVA sunscreens do not. For example, Harding discloses that retinol can be combined with Parsol 1789. (Col. 7, line 17). Clearly, Harding neither teaches, suggests nor recognizes that UVA sunscreens such as Parsol 1789 can degrade retinol[1] and, thus, cannot teach or suggest ways to avoid such degradation.

[1] See, for example, example 2 of the present application.

One skilled in the art, seeking a UVA sunscreen with which he could combine retinol without subjecting the retinol to significant degradation, would not be motivated by Harding to combine retinol with the claimed UVA sunscreens with the expectation that a retinol-stable composition would result.

Forestier does not compensate for Harding's deficiencies. Forestier's camphorsulphonic derivatives were known at the time Harding filed his patent application. Thus, Harding's failure to identify these known sunscreens in his application actually teaches away from combining retinol with the claimed camphorsulphonic derivatives. Why would one skilled in the art be motivated to combine retinol with sunscreen agents which Harding neither teaches nor suggests? Rather, the motivation would be to combine retinol with sunscreen agents suggested by Harding. For this reason alone no *prima facie* case of obviousness has been established.

What's more, Forestier neither teaches nor suggests that his sunscreens will minimize retinol degradation. Thus, nothing in Forestier would lead one skilled in the art to the present invention.

Accordingly, no *prima facie* case of obviousness has been established.

Even assuming *arguendo* that a *prima facie* case of obviousness has been established --which is not the case-- the evidence of record is more than sufficient to overcome such a hypothetical *prima facie* showing. As noted above, the cited art would lead one skilled in the art to expect that the Parsol 1789 and the claimed sunscreens possess equivalent properties, including equivalent retinol degradation properties. However, as demonstrated in the examples of the present application, this is not the case. The claimed camphorsulphonic derivatives possess much

better retinol degradation minimization properties than Parsol 1789. Given that the cited art would lead one skilled in the art to expect the retinol degradation minimization properties of these compounds to be equivalent, the fact that they are significantly different is unexpected. Moreover, it follows that this difference has commercial significance given that minimizing degradation of an active agent (retinol) in a commercial product is desirable because more active agent (retinol) would be available for a longer period of time. Accordingly, the evidence of record is more than sufficient to rebut any arguable *prima facie* case of obviousness based upon the cited references.

In view of the above, Applicants respectfully submit that the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

The Office Action also rejected claims 17 and 18 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action asserted that the present application does not disclose compositions free of histidine. In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

To determine whether histidine free compositions are disclosed in the present application, it must be determined whether, under the totality of the circumstances, the application conveys such compositions to one skilled in the art. *See, In re Parks,* 30 U.S.P.Q.2d 1234 (Bd. Pat. App. & Int. 1993). The exemplified compositions in the present application do not contain histidines and, thus, clearly disclose histidine free compositions. One skilled in the art would easily recognize this fact. Given Boussouira's disclosure concerning the necessity of adding histidines to retinoid containing compositions, one skilled in the art

would recognize the significance of the present application's exemplified compositions being histidine free: that is, the present application discloses a specific retinol/UVA sunscreen combination which allows retinol to be stable without histidines. Under such circumstances, the present application clearly conveys histidine free compositions to one skilled in the art in a manner sufficient to satisfy 35 U.S.C. § 112. *See, In re Parks, supra.*

In view of the above, Applicants respectfully request that the rejection under §112 be reconsidered and withdrawn.

Finally, Applicants respectfully request that the Examiner indicate that the references submitted February 23, 2004, have been considered. A copy of the PTO Form 1449 submitted February 23, 2004, is enclosed for the Examiner's convenience.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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